

Remarks

The paragraphs of the Office action are responded to through the corresponding numbered paragraphs below. The applicant has addressed each issue in turn and, for clarity, has provided a heading for each issue.

Information Disclosure Statement

1. The Examiner indicated that the information disclosure statement filed on July 20, 2001 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 and that it has been placed in the application file and the information referred to therein has been considered as to the merits. The applicant appreciates the Examiner considering this information and believes that no specific response is required to this paragraph.

Claim Rejections – 35 USC § 102

1. The Examiner provided the citation to "35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action." The applicant believes that no specific response is required for this paragraph.

2. The Examiner rejected claims 1–18 "under 35 U.S.C. 102(a) as being anticipated by Amann et al." The applicant has carefully read the cited reference and is not able to find any description of the applicant's invention as claimed in the pending claims. In particular the elements of applicant's claims include quoted passages and the highlighting of such quoted passages, while Amann et al. appears to describe querying typed hypertexts in Multicard/O2 and does not describe the applicant's claimed invention as claimed. The examiner has not presented a *prima facie* case of unpatentability for any claim. Instead, he has simply repeated the elements of each claim and asserted that they are all contained in the cited reference. The examiner provides no evidence of where those claim elements can be found in the cited references, other than a broad range of pages and figures. Mere assertions that a reference anticipates a claim, without indicating what in particular in the reference corresponds to the elements of that claim, are not evidence capable of making a *prima facie* case of unpatentability.

Since the examiner has not make a *prima facie* case of unpatentability in the office action, the applicants are entitled to a patent on the invention as claimed and respectfully request that the examiner withdraw his rejection and allow all pending claims.

Moreover, as noted above, the cited reference does not disclose the elements of the claims. The specification contains particular definitions for a number of the key terms that differentiate the claimed invention over the "prior art" - in particular, "quotation," "source document," and "reference document":

A reference document is a document that contains a quotation of a passage of a source document. . .

A quotation of a passage from a source document means that that passage has been copied from the source document, or another document that itself quoted the source document, when the reference document was created. Such copying could be by copying the passage from the source document using a word processor and then pasting it into the reference document. Alternatively, the passage from the source document could be retyped as the reference document was being written. In either case, access to the source document, or another document quoting from the source document, during the creation of the reference document is necessary and the quotation represents a literal copying of a portion of the source document, the quoted passage. Something is not a quotation simply because it contains some words in common with another document.

As an example, this response is a reference document containing the above quotation from the application, which is the source document. Similar examples are contained in the pending application and in the prosecution history of the parent application.

The examiner has not shown where either the Amann or Osterbye references disclose a reference document that contains a quotation of a passage of a source document, nor can he because neither Amann nor Osterbye disclose any document that contains a quotation from any other document, as that term is defined in the specification.

It is black-letter patent law that an applicant can be his own lexicographer. The many court cases on this point are summarized in MPEP's section 608.01(o)'s statement that "A term used in the claims may be given a special meaning in the description." In construing a claim to determine whether a "prior art" reference discloses an element of that claim, the examiner must use the special mean of a term if it is clear that such a special meaning is intended by the applicant. As seen from the language of the specification quoted above (for example, "A reference document is a document that contains a quotation of a passage of a source document."), it is clear that the applicants

intended special meanings for certain terms in the claims and those special meanings must be used by the examiner.

This is not importing limitations from the specification into claims, as might be the case when the description of the preferred embodiment is used to limit the scope of a claim element. Nor is the examiner allowed to give a claim element its broadest possible interpretation when that interpretation ignores the special meaning given to a term in the claim.

The only qualification of that right of applicants to define the terms in a claim as they wish is that "No term may be given a meaning repugnant to the usual meaning of the term." The examiner has not shown in any way that the definitions of "reference document," "source document," "quotation," or "quoted passage" are in any way repugnant to the usual meaning of the terms. Applicants have defined claim terms in particular ways in the specification, and the examiner is not free to ignore or distort those special meanings.

Another aspect of the invention is that:

The highlighting of a quoted passage in a source document using the techniques of the present invention is inherently dynamic. It is not a static highlighting determined at the time the source document is formatted for the hypertext system, as is the case for the highlighting of a hypertext link, but instead is based on the particular quotation selected by the user. If there are different quotations from the source document, the highlighting will be different depending on the particular quotation selected by the user.

This aspect of the invention is expressed in the claims by the element "where the highlighting of the quoted passage is based on the result of the location step and not highlighting previously in the source document" as well as the specified ordering of the elements of the claimed method as indicated by the connective "and then" which requires the completion of one element of the claim before moving on to the next. Note, in particular, that the "locating step" must occur after the display of the reference document, the selection of the quotation by the user, and the retrieval of the source document containing the quoted passage. And it is not until after the locating step that the claimed highlighting can come into existence.

Neither Amann nor Osterbye disclose highlighting that was not "previously in the source document" and which was "based on the result of the locating step," and therefore cannot anticipate any of the pending claims.

It is not clear what highlighting in Amann or Osterbye the examiner feels corresponds to the claimed highlighting, since he has given no indication beyond a general assertion that the claimed highlighting is disclosed in both those references. But there appears to be no such highlighting in either reference.

In the interview of October 27, 2003, the examiner indicated two classes of "prior art" that he felt would anticipate the claimed invention. Neither do.

The first was a document that contains highlighted hypertext links, that was displayed because a hypertext link to that document was clicked and the document was then retrieved. Presumably the document contain the hypertext link that was clicked is the "reference document" of the claims and the document containing highlighted hypertext links is the "source document."

But the highlighted hypertext links in that "source document" were in that "source document" from the time that that "source document" was created. (For example, for an HTML document, the highlighting was produced because of the "<a>" tags put in the HTML document when it was created.) Any highlighting in the "source document" is the result of markup previously in the "source document" and not as the result of the locating step that occurs after the "source document" has been retrieved, as required by all the claims.

The second class of "prior art" was when search terms are highlighted in a document retrieved as the result of a query to an information retrieval system, such as the Google search engine or the USPTO patent search system. Presumably the retrieved document that contains the highlighted search terms is the "source document."

However, it is not clear what the "reference document" required by the claims and defined in the specification would be. Such a "reference document" must contain "a quotation of a passage of a source document." As stated in the specification and discussed above "A quotation of a passage from a source document means that that passage has been copied from the source document, or another document that itself quoted the source document, when the reference document was created."

Since the "prior art" cited by the examiner in the office action does not anticipate the claimed invention because it does not disclose key elements of each claim, the applicants are entitled to a patent on the invention as claimed and respectfully request that the examiner withdraw his rejection and allow all pending claims.

3. The Examiner rejected claims 1, 7 and 13 "under 35 U.S.C. 102(a) as being anticipated by Osterbye et al. As noted and described in the discussion corresponding to paragraph 2, the applicant has reviewed this reference and is unable to find any description or even suggestion of the elements of applicant's claims. In particular the elements of applicant's claims include quoted passages and the highlighting of such quoted passages, while Osterbye et al. appears to describe hyperlinks used to enable the presentation of a network of nodes rather than the applicant's claimed invention as claimed. Again, the examiner has not presented a *prima facie* case of unpatentability for any claim. Instead, he has simply repeated the elements of the claims and asserted that they are all contained in the cited reference. The examiner provides no evidence of where those claim elements can be found in the cited references, other than a broad range of pages and figures. Since the "prior art" cited by the examiner in the office action does not anticipate the claimed invention because it does not disclose key elements of each claim, the applicants are entitled to a patent on the invention as claimed and respectfully request that the examiner withdraw his rejection and allow all pending claims.

Conclusion

The Examiner has provided information concerning communication and/or inquiries concerning this case. The Examiner indicated that the response to this action should be mailed to: Commissioner of Patents and trademarks, Washington, D.C. 20231." The applicant believes that the current correct address is Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. The applicant received this information from OG Notice 15 April 2003 and respectfully believes the address given by the Examiner is in error. Applicant appreciates the Examiner's willingness to communicate and assist on this case and believes no response to this paragraph is necessary.

The applicant has added claims 19 and 20 to the case, both of which depend on claim 1:

19. The method of claim 1, where said quotation has been copied from said source document, or another document that itself quoted said source document, when said reference document was created.
20. The method of claim 19, where said copying was performed as said reference document was being written by retyping said quoted passage into said reference document or by selecting said quoted passage from said source document and then inserting said selected passage into said reference document using a word processor.

Claim 19 simply restates the definition of a quotation from the specification:

A quotation of a passage from a source document means that that passage has been copied from the source document, or another document that itself quoted the source document, when the reference document was created.

and claim 20 simply elaborates on what it means to copy a quotation from a source document to a reference document, in line with the discussion in the specification:

Such copying could be by copying the passage from the source document using a word processor and then pasting it into the reference document. Alternatively, the passage from the source document could be retyped as the reference document was being written. In either case, access to the source document, or another document quoting from the source document, during the creation of the reference document is necessary and the quotation represents a literal copying of a portion of the source document, the quoted passage. Something is not a quotation simply because it contains some words in common with another document.

Applicants feel that these new claims simply restate what is stated in claim 1 when interpreted in light of the definitions in the specification. They are being presented for examination simply to better frame the issue of whether terms of claim 1 should be given a broader meaning than their definition in the specification, and to make it clear than any prior art must teach the presence of a true quotation from a source document. In the event that claim 1 is allowed, it is our intention to cancel claims 19 and 20 before the issue of the patent. In no event should the doctrine of claim differentiation be used to say that claims 19 and 20 require any different reading of claim 1.

Also, the applicant is puzzled by the examiner's citing the DuFresne 5,835,712 patent as a reference. It was issued on November 10, 1998, based on a May 3, 1996 application. Applicants' application is a continuation-in-part of application 08/363,772, filed on December 22, 1994. The '712 patent would not be prior art under any of the alternatives in 35 USC § 102.

In the interview of October 27, 2003, the examiner indicated that he cited the '712 patent as a reference simply to indicate that he was unable to find any United States patent prior to the '712 patent that disclosed the claimed invention. If that is the case, the examiner should clearly state that it is his opinion that there is no relevant United States patent prior art before the '712 patent to make it clear that he has searched such art and that there is none.

App. S/N: 09/909,516
Filing Date: 07/20/2001

AMENDMENT AND RESPONSE
TO NON-FINAL OFFICE ACTION

Exr. Frantz Coby
Group Art Unit: 2171

As previously noted, the applicant believes that the Examiner has not presented a prima facie case of unpatenability for any of the pending claims. The applicant has pointed out in the discussion of this action a number of elements that are neither described nor even suggested by the cited references. Applicant believes that all issues and points of the Examiner's Office action have been addressed. Applicant believes that claims 1-20 are patentable over all known prior art. Applicant respectfully requests reconsideration and allowance of this application.

Respectfully submitted this 23rd day of December, 2003.



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